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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,492	02/27/2002	David Farcot	P21987	8439

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EXAMINER

BOTTORFF, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,492

Applicant(s)

FARCOT ET AL. *ES*

Examiner

Christopher Bottorff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-19 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 13-18, 23-25 and 28-30 is/are rejected.
- 7) ☒ Claim(s) 5, 11, 19, 21, 22, 26, 27, 31, 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The amendment filed April 17, 2003 has been entered. Claims 12 and 20 are canceled. Claims 21-32 are added. Claims 1-11, 13-19, and 21-32 are pending.

Also, the previous objection to the specification and rejection under 35 USC §112, first paragraph, are withdrawn. However, a new rejection under 35 USC §112, first paragraph, is outlined below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24, 25, 29, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 24, 25, 29, and 30 extend the range of the thickness of the plate beyond the range established in the specification. Paragraph 0038 in the specification limits the range to between 0.1 mm and 1.0 mm. However, the claims extend the range to 3.0 mm.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-10, 13-18, 23-25, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller et al. US 5,909,893 in view of Tanaka US 6,386,574 and Vitali et al. US 5,380,031.

Keller et al. discloses an assembly for retaining a boot on a sports apparatus. See figure 3; column 2, lines 44-50; and column 4, lines 6-29. The assembly has a disk 1 that retains a base, wherein the disk includes four elongated holes 10 that extend through a thickness of the disk, are parallel to one another, are aligned in pairs, are elongated in the same direction, and are across from one another. Also, two generally rectangular plates 12 that are parallel to the disk and are housed in a cavity 11 of the disk, wherein the cavity has a generally parallelepipedic contour. Each plate includes two holes 13 extending through a thickness of the plate and each plate slides along the length of the elongated holes. At least two screws 8 extend through the elongated holes of the disk and the holes of each plate.

While Keller et al. suggests that the disk is retained in a base, a base is not explicitly disclosed. Furthermore, Keller et al does not disclose a retaining means for retaining the screws on the plate, wherein the means is a plate hole with a diameter

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substantially equal to the diameter of the threaded portion of the screw, and the screw head and threaded portion interact with the plate hole to retain the screw on the plate as discussed in paragraphs 0039 – 0043. Keller et al. does not disclose that the plate is made of plastic or metal. Keller et al. does not disclose the precise thickness of the plate, although it appears to be between 0.1 mm and 1.0 mm based upon the proportions depicted in Figure 3. In addition, the plate is not square with four holes spread to the four corners or three holes arranged at vertices of a triangle, and the plate is not located on the lower portion of the disk.

However, Tanaka teaches that the practice of providing a disk 72 in a base 14 of a boot-retaining apparatus was old and well known in the art at the time the invention was made. See figure 1 and column 2, lines 44-45. From the teaching of Tanaka, providing the assembly of Keller et al. with a base would have been obvious to one of ordinary skill in the art at the time the invention was made. Such a modification would allow the assembly to receive the sole of a boot.

Also, Vitali et al. teaches the old and well known retaining means for retaining a screws on a plate, and teaches plate materials and thickness. See Figures 1-6 and column 3, lines 4-16, 23-29, 39-52, and 63-67. The retaining means includes a plate hole 7 with a diameter 9 substantially equal to the diameter of the threaded portion of a screw 1. The screw is sized, relative to the plate hole, to be forcibly screwed through the plate hole, thereby allowing the screw head and threaded portion to interact with the plate hole to retain the screw on the plate when assembled. Also, the plate may be made of either plastic or metal and has a thickness of between 0.1 mm and 1.0 mm.

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From the teachings of Vitali et al., providing the assembly of Keller et al. with a retaining means for retaining the screws on the plate would have been obvious to one of ordinary skill in the art at the time the invention was made. This would aid in assembly by precisely providing a desired screw length protruding beneath the lower surface of the binding. Also, from the teachings of Vitali et al., providing the assembly of Keller et al. with a plate made of plastic or metal and of the claimed thickness would have been obvious to one of ordinary skill in the art at the time the invention was made. This would ensure that the plate has sufficient strength.

In regard to the generally square shape of the plate, providing the plates of Keller et al. in a generally square shape, rather than two rectangles, represents an obvious design choice that was within the purview of one of ordinary skill in the art at the time the invention was made. The court has held that the shape of a component is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant. *In re Dailey*, 149 USPQ 47 (CCPA 1966). Moreover, in paragraph 0037 on page 7 of the specification Applicants state that the shape of the plate is not a critical feature.

In regard to claim 6, arranging each of the plates of Keller et al. with three holes, rather than two, and arranging the disk with three holes aligned along their length direction, rather than two, with three screws extending through the holes, rather than two, represents an obvious duplication of parts that would not produce a new and unexpected result. It is well settled that mere duplication of parts has no patentable

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significance unless a new and unexpected result is produced. *In re Harza*, 124 USPQ 378 (CCPA 1960).

Furthermore, arranging the plate on the lower portion of the disk, rather than in a cavity of the disk, represents an obvious reversal of parts. It is well settled that merely reversing the parts of an apparatus is an obvious expedient. See *In re Gazda*, 104USPQ 400 (CCPA 1955).

Allowable Subject Matter

Claims 5, 11, 19, 21, 22, 26, 27, 31, and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims define the plate hole arrangement as being four holes positioned at four corners of a square or three holes arranged at vertices of a triangle. The prior art does not teach such a plate hole arrangement.

Response to Arguments

Applicant's arguments filed April 17, 2003 have been fully considered but they are not persuasive.

The objection to the specification is withdrawn because the screw-threaded engagement will exist when the screw is being passed through the plate during assembly. This description aides in the understanding of the screw and plate relationship. However, the screw-threaded engagement condition only exists during

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that step in the assembly process and does not exist in the final assembly. The pending claims, and all claims presented to date, have been directed to the final assembly and not various stages of the assembly process. Thus, the screw-threaded engagement limitations have been appropriately amended out of the claims.

In regard to the limitation reciting a "single" plate, Keller et al. has a single plate with two screws passing through that plate. Although Keller et al. has an additional plate with two additional screws passing through that plate, the claims do not exclude the presence of an additional plate. Consequently, defining a "single" plate fails to distinguish over the prior art.

In regard to the limitation reciting a "retaining means for retaining the screws on the plate," the examiner acknowledges that Applicants invoke 35 USC § 112, sixth paragraph. However, Vitali et al. teaches the retaining means described in the specification, and modifying the arrangement of Keller et al. in light of the teachings of Vitali et al. would have been obvious.

As discussed in the rejection above, the claims fail to distinguish over the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sedlmair, Mayr et al., and Eaton et al. disclose screw retaining arrangements.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Christopher Bottorff
May 14, 2003